



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,863	12/21/2000	Howard Shelton Lambert	GB999141USI	2220

46369 7590 12/12/2005

HESLIN ROTHENBERG FARLEY & MESITI P.C.
5 COLUMBIA CIRCLE
ALBANY, NY 12203

EXAMINER

SIMITOSKI, MICHAEL J

ART UNIT	PAPER NUMBER
----------	--------------

2134

DATE MAILED: 12/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/745,863	Applicant(s) LAMBERT ET AL.	
	Examiner Michael J. Simitoski	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The pre-appeal decision of 10/21/2005 renders prosecution reopened.
2. Claims 1-14 are pending.

Response to Arguments

3. The rejection of claims 1-14 under 35 U.S.C. §102(b) and §103(a), set forth in the previous Office Action are withdrawn.
4. In view of the pre-appeal brief review mailed on 10/21/2005, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 5, the limitation "said identified cryptor, compressor and authenticator" renders the claim indefinite because the method only requires one of a cryptor, compress or authenticator. *For the purposes of this Office Action, the limitation "said identified cryptor, compressor and authenticator" is understood to read, "said identified cryptor, compressor or authenticator".*

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-2, 4 & 7-14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,775,655 to Peinado et al. (**Peinado**).

Regarding claims 1 & 7-14, Peinado discloses in response to a request from a requestor for access to data stored in an encoded form on a first digital processing apparatus/user's computing device (Fig. 1, col. 2, lines 53-62 & col. 14, lines 1-12), sending a request from a decoding controller/black box on the first data processing apparatus/user's computing device to a

Art Unit: 2134

second data processing apparatus/license server to determine attributes/license of a decoding process for accessing the encoded data (col. 18, lines 26-53, col. 19, lines 17-18, lines 33-40 & col. 21, lines 36-45), in response to said request to the second data processing apparatus, receiving said determined attributes/license at said decoding controller/black box (col. 21, lines 36-45), performing the decoding process in accordance with the determined attributes/license (col. 23, lines 46-55).

Regarding claim 2, Peinado discloses the requestor communicating via an application-programming interface with a data access manager/DRM system (Fig. 5B, #511 & col. 13, lines 46-57).

Regarding claim 4, Peinado discloses the attribute containing an identifier of a compressor (col. 29, lines 60-65).

9. Claims 1, 3 & 7-14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,625,734 to Marvit et al. (**Marvit**).

Regarding claims 1, 7 & 10-14, Marvit discloses in response to a request from a requestor for access to data/message stored in an encoded form on a first data processing apparatus/user 102's computer (col. 5, lines 57-63), sending a request from a decoding controller on the first data processing apparatus to a second data processing apparatus/key repository to determine attributes/keys of a decoding process for accessing the encoded data (col. 5, lines 57-63), in response to said request to the second data processing apparatus, receiving said determined attributes/key at said decoding controller (col. 6, lines 1-2) and performing the decoding process in accordance with the determined attributes/key (col. 6, lines 3-6).

Regarding claim 3, Marvit discloses wherein the received attributes/keys are stored in volatile memory of the first data processing apparatus when received (Fig. 11, col. 6, lines 1-6, col. 16, lines 44-47, col. 21, line 1), and are deleted from said memory at the end of a current requestor session, such that a request to determine attributes of a decoding process must be repeated for each requestor session for which access to encoded data is required (col. 6, lines 4-6 & lines 35-40).

Regarding claim 8, Marvit discloses logging said requests to determine attributes (col. 7, lines 62-63).

Regarding claim 9, Marvit discloses authenticating the requestor (col. 5, lines 22-26).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Peinado**, as applied to claims 1 & 4 above, in view of U.S. Patent 6,421,726 to Kenner et al. (**Kenner**).

Regarding claims 5-6, as best understood, Peinado lacks checking whether program code implementing said compressor is stored on the first data processing apparatus and if not, initiating downloading of the respective program code. However, Kenner teaches a system where if a CODEC is not available on the system, the system can automatically download a CODEC/program code that will decode the media (col. 18, line 66 – col. 19, line 5). Therefore,

Art Unit: 2134

it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peinado to check whether program code implementing the compressor is stored on the first data processing apparatus/user's computing device and if not, initiating downloading of the respective program code/CODEC. One of ordinary skill in the art would have been motivated to perform such a modification to automatically install a necessary CODEC, as taught by Kenner (col. 18, line 66 – col. 19, line 5).

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (571) 272-3841. The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m.. The examiner can also be reached on alternate Fridays from 6:45 a.m. – 3:15 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached at (571) 272-3838.

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300
(for formal communications intended for entry)

Or:

(571) 273-3841 (Examiner's fax, for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Art Unit: 2134

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MJS

November 30, 2005



GREGORY MORZE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1100